

### **REMARKS/ARGUMENTS**

Claims 46-91 are pending. By this Amendment, claims 92 and 93 are canceled. This Amendment is being filed just before the filing of a Pre-Appeal Brief Request for Review.

In the Office Action, claims 90-93 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. By this Amendment, claims 92 and 93 are canceled for clarity only. In addition, as regards to the rejection applied to claims 90 and 91, the rejection is respectfully traversed.

Claims 90 and 91 are directed to “a computer readable storage medium tangibly storing software...”. As such, each of claims 90 and 92 is a so-called “Beauregard claim.” As the Board of Patent Appeals and Interferences recently explained in the aftermath of *Bilski* in *Ex parte Bo Li*, Appeal 2008-1213, decided on November 6, 2008 at p. 9, Beauregard claims qualify as patentable:

“It has been the practice for a number of years that a ‘Beauregard Claim’ of this nature be considered statutory at the USPTO as a product claim. (MPEP 2105.01, I). Though not finally adjudicated, this practice is not inconsistent with *In re Nuijten*. Further, the instant claim presents a number of software components, such as the claimed logic processing module, configuration file processing module, data organization module, and data display organization module, that are embodied upon a computer readable medium. This combination has been found statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994). In view of the totality of these precedents, we decline to support the rejection under 35 U.S.C. § 101.”

In view of the fact that each of claims 90 and 91 is a “Beauregard claim” directed to “a computer readable storage medium tangibly storing software” for carrying out the claimed method, claims 90 and 91 are directly analogous to *Ex parte Bo Li*. Thus, claims 90 and 91 clearly are directed to statutory subject matter.

Moreover, the Examiner’s analysis of claims 90 and 91 as possibly encompassing a “signal” is improper as claims 90 and 91 are expressly limited to software. However, to make even more clear what Applicants claim, Applicants are willing to amend claims 90 and 91 to

specify “a computer readable storage medium tangibly storing software executable by a computer...”.

In paragraph 6 of the Office Action, the specification is objected to under 37 CFR §1.75(d)(1). However, as claims 92 and 93 are canceled, and claims 90 and 91 are directed towards “software” – a term readily understood to those of ordinary skill in the art as encompassing, e.g., a disk, CD-ROM, a DVD-ROM, etc. - it is believed that the specification objection as to the terms readable storage medium or storage media is moot.

In paragraph 7 of the Office Action, the Examiner suggests that claims 47-67 be changed to specify “the method” instead of “a method” in line 1 of each claim. Applicants respectfully decline to accept the Examiner’s suggestion at this point as unnecessary, but Applicants are open to such change via Examiner’s amendment.

Claims 46-56, 62-66, 68-78 and 84-93 were rejected under 35 U.S.C. §103(a) over Tanaka et al. (U.S. Patent No.6,665,735) in view of Bills et al. (U.S. Patent Publication No. 2003/0204479 A1). In addition, claims 57-59 and 79-81 were rejected under 35 U.S.C. §103(a) over Tanaka et al. in view of Bills et al., and further in view of Owen (U.S. Patent Publication No. 2003/0217031 A1). Further, claim 60, 61, 82 and 83 were rejected under 35 U.S.C. §103(a) over Tanaka et al. in view of Bills et al., and further in view of Suzuki (U.S. Patent No. 6,829,768 B1). Finally, claim 67 was rejected under 35 U.S.C. §103(a) over Bills et al. in view of Cloud (U.S. Patent No. 6,253,369 B1). These rejections are respectfully traversed at least for the reasons set forth in the March 10, 2009 Pre-Appeal Brief Request for Review (incorporated herein by reference in its entirety).

In view of the above amendments and remarks, Applicants respectfully submit that all the claims are patentable and that the entire application is in condition for allowance.

TARBELL et al.  
Appl. No. 10/531,260  
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The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140 under Order No. PTB-4942-5.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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